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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,105	11/23/2005	John Claude Husband	07812.0058-00	8404
22852	7590	10/17/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PAK, HANNAH J	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			10/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/523,105

**Applicant(s)**

HUSBAND ET AL.

**Examiner**

Hannah Pak

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

1. All outstanding 102 (e) and 112, 2<sup>nd</sup> paragraph rejections, except for those maintained below, are withdrawn in light of applicants' amendment/remarks filed on 08/11/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

***Claim Rejections - 35 USC § 103***

4. Claims 39-49 and 51-77 are rejected under 35 U.S.C. 103 as being unpatentable over Mortimer et al. (US 6,620,856) in view of Engraz et al. (US 5,432,239).

The rejection is adequately set forth in Pages 3-6 of Office action mailed on 05/28/2008 and is incorporated here by reference.

5. Claim 50 is rejected under 35 U.S.C. 103 as being unpatentable over Mortimer et al. (US 6,620,856) in view of Engraz et al. (US 5,432,239) as applied to claims 39-49 and 51-77 above, and further in view of Nagaraj et al. (US 2001/0022282).

The rejection is adequately set forth in Page 6 of Office action mailed on 05/28/2008 and is incorporated here by reference.

6. Claim 78 is rejected under 35 U.S.C. 103 as being unpatentable over Mortimer et al. (US 6,620,856) in view of Engraz et al. (US 5,432,239) as applied to claims 39-49 and 51-77 above, and further in view of Leighton et al. (US 4,915,845).

The rejection is adequately set forth in Page 7 of Office action mailed on 05/28/2008 and is incorporated here by reference.

### ***Response to Arguments***

7. Applicants' arguments filed 08/11/2008 have been fully considered but they are not persuasive. Specifically, the applicants argue **(A)** that for claim rejections under 35 U.S.C. 103, the references, Mortimer et al. and Engraz et al., do not teach using a "sub-effective amount" of at least one dispersant in an aqueous solution of a ground inorganic particulate material (see Pages 7-8 and 10-12 of the Applicant's Remarks). The applicants also argue **(B)** that Mortimer et al. itself teach away from using "sub-effective amount" of dispersant during grinding by stating the amount of dispersant is to be "effective" (Col. 3, line 67-Col. 4, line 4) (see Page 10 of the Applicants' Remarks).

With respect to arguments **(A)** and **(B)**: According to page 3, lines 6-10 of the specification:

"The 'term 'sub-effective' means that the dispersant is present in a finite amount, but that amount is not sufficient to give rise to deflocculation of the particulate inorganic material, so that the flocculation characteristics of the suspension are substantially the same as would be found in the complete absence of any dispersant."

The applicants further define such amounts as up to about 0.25% by weight, based on the weight of dry inorganic particulate, for example up to about 0.15% by weight, e.g. up to about 0.1% by weight (Page 3, lines 10-13 of the specification). These amounts of

dispersants used are also recited in claims 44-47. The applicants' arguments were misleading in that the applicants exclude an essential part ("finite amount") when defining the term "sub-effective" amount (see page 3 of the Applicant's Remarks). Based on the definition and examples from the specification given above, Mortimer et al. teach an overlapping amount of dispersants, from 0.01-2.0 percent by weight, based on the dry weight of the inorganic particulate present (Compare Col. 4, lines 1-5 with claims 44-47 and Page 3, lines 10-13 of the specification). This is also repeated on Page 4 of the Office action. Mortimer et al. do not teach away from the term as well. Moreover, the other reference, Engraz et al., teach employing an overlapping amount of 0.2 to 2.0% by weight of grinding/dispersing agent in the aqueous suspension, based on the dry weight of the mineral substance (Col. 12, lines 1-5). Accordingly, Mortimer et al.'s and Engraz's amounts of dispersants are included by the term, "sub-effective" amount, and is continued to be relied upon to reject the instant claims.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571)270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak

Art Unit: 1796

Examiner  
Art Unit 1796

/HP/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796